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REMARKS1. Status of the Claims

Claims 2-21 have been canceled. Applicant respectfully requests that new claims 22-37 be entered into the application. Therefore, claims 1 and 22-37 are currently pending. No new matter is added by way of the present amendments. Support for new claims 22-37 can be found in originally filed claims 1-21 and in the specification, for example, at page 32, lines 11-13. Reconsideration and reexamination of the present application is respectfully requested in view of the amendments above and the remarks below.

2. IDS Filed April 27, 2003

The Examiner asserts at page 2 in the Office Action mailed June, 8, 2004 (hereinafter the "Action") that the IDS filed April 27, 2003 did not have a PTO-1449 attached, or references attached. Applicant's records do not indicate that an IDS was filed on or about April 27, 2003. An IDS was filed April 5, 2002, and the associated postcard was date stamped by the PTO as having been received April 17, 2002. Applicant respectfully requests that the Examiner clarify the present objection or contact the undersigned to clarify this matter.

3. Priority

The Examiner asserts at page 2 of the Action that "priority is set to October 16, 2004". Applicants respectfully submit that the priority claim is to October 16, 1998 (not 2004). Applicant submits a copy of the Filing Receipt mailed June 23, 2003 as evidence that the priority claim is to October 16, 1998. Applicant respectfully requests that the Examiner make note of

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the proper priority claim in the next Office Action.

4. Nonstatutory Double Patenting

The Examiner rejected claims 1-19 under the judicially created doctrine of obviousness-type double patenting as alleged being unpatentable over claims 28-56 of U.S. Patent No. 6,242,568 (hereinafter the '568 patent). Applicant respectfully traverses the present rejection.

Claims 2-19 are canceled. Accordingly, the present rejection of claims 2-19 is moot.

In regard to claim 1, the Examiner asserts that "the claims are overlapping such that one set of claims are obvious over the other set of claims". This is an unsupported assertion and does not establish a *prima facie* case of obviousness-type double patenting. Furthermore, claim 1, as amended, relates to an isolated and purified zinc finger-nucleotide binding polypeptide that consists essentially of a nucleotide binding region having the sequence of SEQ ID NO:41. The '568 patent, however, does not teach or suggest a modification to arrive at the polypeptide of claim 1. Therefore, claim 1 cannot be obvious over claims 28-56 of the '568 patent because '568 does not teach or suggest the invention of claim 1.

Claims 1-13 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-3, 5-39, and 53 of U.S. Patent No. 6,140,466 (hereinafter the '466 patent). The present rejection is respectfully traversed.

Claims 2-13 are canceled. Accordingly, the present rejection of claims 2-13 is moot.

In regard to claim 1, the Examiner asserts that "the claims are overlapping such that one set of claims are obvious over the

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other set of claims". This is an unsupported assertion and does not establish a *prima facie* case of obviousness-type double patenting. Furthermore, claim 1, as amended, relates to an isolated and purified zinc finger-nucleotide binding polypeptide that consists essentially of a nucleotide binding region having the sequence of SEQ ID NO:41. The '466 patent, however, does not teach or suggest a modification to arrive at the polypeptide of claim 1. Therefore, claim 1 cannot be obvious over claims 1-3, 5-39, or 53 of the '466 patent because '466 does not teach or suggest the invention of claim 1.

5. Rejection Under 35 U.S.C. 112, Second Paragraph

Claims 20 and 21 are rejected as allegedly being indefinite, implying that they are rejected under 35 U.S.C. 112, second paragraph. In view of the cancellation of claims 20 and 21, the present rejection is moot.

6. Rejection Under 35 U.S.C. 101

Claims 20 and 21 are rejected under 35 U.S.C. 101 because claims 20 and 21 allegedly do not recite any steps involved in the process recited in the claims. In view of the cancellation of claims 20 and 21, the present rejection is moot.

7. Additional Rejection Under 35 U.S.C. 112, Second Paragraph

Claims 1-21 are rejected under 35 U.S.C., second paragraph, as allegedly being indefinite. The present rejection is respectfully traversed.

The Examiner asserts at the bottom of page 3 of the Action that claims 1-21 are allegedly drawn to non-elected subject matter and therefore, the claims allegedly are indefinite because it is not clear what the Applicant regards as the elected

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invention. Claims 2-21 are canceled, therefore, the present rejection is moot in regard to claims 2-21. Claim 1, as amended is related to SEQ ID NO:41, which election was made with traverse in the Response mailed March 3, 2004 (which Response was resubmitted April 15, 2004). Therefore, the present rejection is believed to be moot in regard to claim 1, as amended, because claim 1 recites the elected invention.

8. Rejection Under 35 U.S.C. 102(e)

Claims 1-3 and 5-13 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 6,242,568 (the '568 patent). The present rejection is respectfully traversed.

The Examiner asserts on page 4 of the Action that the '568 patent allegedly teaches C7 zinc finger nucleotide binding polypeptide containing instant SEQ ID NO:41 (KSADLKR) in Figure 15 and in SEQ ID NO:42 (amino acid residues 20-26) of the '568 patent and that these teachings in the '568 patent allegedly anticipate claim 1. Applicant respectfully submits that claim 1, as amended, relates to an isolated and purified zinc finger-nucleotide binding polypeptide that consists essentially of a nucleotide binding region having the sequence of SEQ ID NO:41. The '568 patent does not teach or suggest an isolated and purified polypeptide that consists essentially of SEQ ID NO:41, therefore, the present rejection should be withdrawn.

Claims 2-3 and 5-13 are canceled; therefore, the present rejection is moot in respect to the present claims.

9. Rejection Under 35 U.S.C. 103(a)

Claims 2-7 and 14-22 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,242,568 (the '568 patent). In view of the cancellation of claims 2-7 and 14-

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22, the present rejection is moot.

10. U.S. Patent No. 6,140,466

The Examiner asserts that U.S. Patent 6,140,446 "is the same up through Example 13 of USP 6,242,568 and would be applied in the same manner as 6,242,568". Accordingly, the same remarks presented above in regard to the 6,242,568 patent apply to the 6,140,466 patent.

CONCLUSION

Claims 1 and 22-37 are pending in the present application. Applicant believes that claims 1 and 22-37 are in condition for allowance and earnestly solicits an early notification of allowance from the Examiner.

The Commissioner is hereby authorized to charge Deposit Account No. 19-0962, should any additional fees be required in this application.

Respectfully submitted,

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Date


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